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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,379	11/19/2003	Bruce M. Frankel	ZIMM1480	6700
44654	7590	07/21/2009	EXAMINER	
SPRINKLE IP LAW GROUP 1301 W. 25TH STREET SUITE 408 AUSTIN, TX 78705			RAMANA, ANURADHA	
ART UNIT	PAPER NUMBER		3775	
MAIL DATE	DELIVERY MODE			
07/21/2009	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/717,379	<b>Applicant(s)</b> FRANKEL ET AL.
	<b>Examiner</b> Anu Ramana	<b>Art Unit</b> 3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 April 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 23-27 and 31-45 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 23,26-27,31-33, and 36-45 is/are rejected.

7) Claim(s) 24,25,34 and 35 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/22/09; 5/15/09

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 31-32 and 38-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 31 and 38, the recitations "a first location in the opening in the bone formed by the bone tap" and " a second location in the opening in the bone formed by the bone tap" are deemed to be new matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Vrespa (EP 0557899 A1).

Vrespa discloses a method including the steps of: introducing a tapper into bone; introducing isotonic fluids to reduce bone necrosis wherein the fluid is introduced through a coaxial channel and lateral apertures in the tapper; and completely screwing a screw 10 or fastener in the tapped hole (Figs. 6 and 7, col. 20, lines 48-58 and col. 21, lines 1-5). The step of withdrawing the tapper is inherent in the method disclosed by

Vrespa since the tapper has to be removed in order for the screw 10 to be placed in the tapped hole.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vrespa in view of Yeomans (US 4653338).

Vrespa discloses all elements of the claimed invention except for a driver removably coupled to the bone tap.

It is well known to attach a driver to a bone tap for the purpose of driving the bone tap, as evidenced by Yeomans (col. 3, lines 17-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached a driver, as taught by Yeomans, to the bone tap of Vrespa, for the purpose of driving the bone tap into bone.

Claims 27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vrespa in view of Daniel et al. (US 6622731).

Vrespa discloses all elements of the claimed invention except for a fluid delivery device such as a syringe or a peristaltic pump.

It is well known to attach a fluid delivery device such as a syringe or a peristaltic pump, to a hollow device, for fluid delivery through the device as evidenced by Daniel et al. (col. 8, lines 4-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached a fluid delivery device such as a syringe or a peristaltic pump, as taught by Daniel et al., to the Vrespa tapper to deliver the

cooling fluid, since it was well known in the art to attach a fluid delivery device to deliver fluid through a hollow device.

***Response to Arguments***

Applicant's arguments filed on April 15, 2009 have been fully considered but are moot in view of the new grounds of rejection.

***Allowable Subject Matter***

Claims 24, 25, 34 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached at (571) 272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
July 17, 2009

/Anu Ramana/  
Primary Examiner, Art Unit 3775